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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,757	04/14/2004	Yasufumi Kaneda	59150-8010.US00	7091
22918	7590	03/27/2007		
PERKINS COIE LLP P.O. BOX 2168 MENLO PARK, CA 94026			EXAMINER WHITEMAN, BRIAN A	
			ART UNIT	PAPER NUMBER
			1635	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/27/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/824,757

Applicant(s)

KANEDA, YASUFUMI

Examiner

Brian Whiteman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-6,8,9,11-14,16,18,23,25,26 and 30 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-6,8,9,11-14,23,26 is/are rejected.
- 7) ☒ Claim(s) 16,18 and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/13/06, 2/27/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

Claims 1, 2, 4-6, 8, 9, 11-14, 16, 18, 23, 25, 26, and 30 are pending.

#### ***Election/Restrictions***

Claims 4 and 25 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/24/06.

#### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 9/13/06 and 2/27/07 was filed after the mailing date of the non-final rejection on 7/24/06. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The limitation “for introducing a gene into animal in vivo tissue” in claims 11 and 12 does not have patentable weight over the prior art. See MPEP 2111.

The limitation “kit for screening gene libraries” in claims 14 and 26 does not have patentable weight over the prior art. See MPEP 2111.

The limitation “pharmaceutical” in claims 13 and 23 does not have patentable weight over the prior art. See MPEP 2111.

Claims 1 and claims dependent therefrom (claims 2, 5, 6, 8, 9, 11, 12, 13, 14, 23, and 26 read on a virus comprising a viral vector comprising an exogenous gene, wherein the virus does not replicate viral proteins. See page of the instant specification.

Claims 5, 6, and 8-9 are directed to a product by process. Thus, if the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The product in claims 5, 6, 8 and 9 read on a replication defective herpes virus comprising a gene transfer vector comprising an exogenous gene.

Claims 1, 2, 5, 6, 8, 9, 11, 12, 13, 14, 23, and 26 remain rejected under 35 U.S.C. 102(e) as being anticipated by Fong et al. (US 6,051,428). Fong teaches a replication defective herpes virus (amplicon) comprising a transgene (column 1). Fong teaches administering Triton X-100 to an isolated cell infected with the replication defective herpes virus (column 24).

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Applicant's arguments filed 10/24/06 have been fully considered but they are not persuasive.

In response to applicant's argument that the replication defective HSV amplicon vector taught by Fong (referring to Geller and Breakfield (Science 241:1667-1669, 1988, enclosed) is not inactivated as presently claimed, the argument is not found persuasive because the skilled artisan understands that HSV amplicon vectors do not express endogenous viral proteins (see Kwong et al. Journal of Virology 51:595-603, 1984). Furthermore, the term "inactivated" in claim 1 is broad and reads on a vector that does not express viral proteins. In addition, the Geller et al. reference is not of record (or enclosed in applicant's response) as asserted by applicant.

In response to applicant's argument to the method claims, the argument is found persuasive and the rejection against the claimed method(s) is withdrawn.

#### ***Response to Arguments***

Applicant's arguments, see paged 6-7, filed 10/24/06, with respect to 102(e) over Epstein have been fully considered and are persuasive. The rejection of Claims 1, 2, 5, 6, 8, 9, 11, 12, 13, 14, 23, and 26 and 30 are has been withdrawn because the herpes viral vector could embrace a virus the expresses viral proteins.

Applicant's arguments, see paged 6-8, filed 10/24/06, with respect to 102(e) over Altieri have been fully considered and are persuasive. The rejection of Claims 1, 2, 5, 6, 8, 9, 11, 12, 13, 14, 23, and 26 and 30 are has been withdrawn because the herpes viral vector could embrace a virus the expresses viral proteins.

***Conclusion***

Claims 16, 18 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 16, 18, and 30 are free of the prior art of record.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Whiteman whose telephone number is (571) 272-0764. The examiner can normally be reached on Monday through Friday from 7:00 to 4:00 (Eastern Standard Time), with alternating Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas Schultz, PhD, SPE – Art Unit 1635, can be reached at (571) 272-0763.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Fax Center number is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Brian Whiteman

A handwritten signature in black ink, appearing to be 'B. Whiteman', with a long horizontal stroke extending to the right.